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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,246	08/20/2003	Gary Hochman	0813-017P/JAB	6059

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SCHWEITZER CORNMAN GROSS & BONDELL LLP
292 MADISON AVENUE - 19th FLOOR
NEW YORK, NY 10017

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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06/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/644,246

Applicant(s)

HOCHMAN, GARY

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive. Applicant argues that steps such as "include the step of "inserting at the location of the sender into a data transmission including an image format portion data identifying the address of the intended recipient of the image format portion of the transmission and message tracking data" are not taught by Hughes-Hartogs, Examiner disagrees and points out column 5, lines 19-22, where the facsimile distribution is done based on the received three-digit address that has been originated by the sender of the facsimile, or other words, inserted to the facsimile by the sender. Applicant also argues on page, also the same passage would clearly disclose that the formatting of the header would include distribution of the data based on the formatted header and the three digit address. Applicant argues that "Hughes-Hartogs is entirely silent with regard to possible insertion of address or message tracking data into the transmission. Examiner disagrees and points out column 7, lines 1-8, where the facsimile track data is determined by tracking the facsimile length and the destination embedded to the sending facsimile. Applicant argues that

" Hughes-Hartogs does not teach the insertion of message tracking data comprising at least one of accounting audit and documentation data and that there is absolutely no teaching, nor even suggestion, of the alteration of the outgoing fax by the entry of such data into the fax transmission itself. Examiner disagrees and points out that the insertion at the location of the sender would in fact is disclosed by Hughes-Hartogs, column 5, lines 15-22, where the

computers 41 and 42 which send the fax are in fact inset information such as accounting information or placing date and time stamp and providing formatting header information.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes-Hartogs (U.S. patent 5,657,381)

Regarding claims 1 and 10 Hughes-Hartogs discloses: discloses: A method for the transmission of image data from a sender (note Figs.2&3, column 5 lines 1-7, where the MUXs 31 and 31 with the computers 41 and 42) to a recipient (note Fig.2 and 3, items 62,64 and 66 column 5 lines 8-9) comprising the steps of: inserting at the location of the sender into a data

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transmission including an image format portion data identifying the address of the intended recipient of the image-format portion of the transmission (note column 5, lines 9-14, where the format is changed to be acceptable to the recipient) and message tracking data (note column 7 lines 2-8 where the accounting information is tagged at the sending devices 62-66, lines 6-8) transmitting the data transmission over a transmission system from the sender's location to an intermediate point of presence facility (note column Figs. 2,3 and 4 item 50 the Fax server or in this case the point of presence facility, column 5 lines 15-17) and receiving the data transmission by the point of presence facility and re-transmitting the data comprising the image portion to the identified address of the recipient (note column 5 lines 15-27 where the Fax server 50 would reformat and comply the accounting information and re-transmit the data to the recipients addresses or Faxes).

Regarding claim 2 and 14 Hughes-Hartogs discloses: The method of claim 1 wherein the message tracking data inserted comprises at least one of accounting, audit and documentation data (note column 7 lines 5-8, also note column 5, lines 15-27):

Regarding claim 3 Hughes-Hartogs discloses: the method of claim 2 further including the step of processing the message tracking data by the point of presence facility (note column 5 lines 15-27, where the point of presence is in this case the Fax server 50).

Regarding claim 4 Hughes-Hartogs discloses: The method of claim 3 including the further step of stripping the message tracking data from the data transmission at the point of presence facility before retransmission (note column 5 lines, 17-19 where the accounting information is complied and considered).

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Regarding claim 5 Hughes-Hartogs discloses: The method of claim 1 further including the steps of: inserting at the location of the sender into the data transmission data identifying an address of the sender; and sending a confirmation message to the sender's address by the point of presence facility after re-transmitting the data comprising the image portion to the recipient's identified address (note column 5 lines 28-43 where the Fax document is emailed to the recipient).

Regarding claim 6 and 7 Hughes-Hartogs discloses: the method of claim 1, wherein the address of the recipient is an email address and the step of retransmitting the data includes forwarding the data in the form of an email attachment to the recipient email address (note again column 5 lines 28-43).

Regarding claim 8 Hughes-Hartogs discloses: The method of claim 6, wherein the address of the sender is an e-mail address and the step of sending a confirmation message includes forwarding an e-mail message to the sender's e-mail address (note column 5 lines 35-43).

Regarding claim 11 Hughes-Hartogs discloses: The method of claim 10 wherein the identified address of the recipient is a telephone number associated with a facsimile reception apparatus and said re-transmission includes a portion over a telephone line linked to the facsimile reception apparatus (note column 4 lines 1-20).

Regarding claim 12 Hughes-Hartogs discloses: The method of claim 10 wherein the transmission from the sender to the point of presence Facility is in the form of an e-mail transmission (note column 5 lines 35-43).

Regarding claim 13 Hughes-Hartogs discloses: The method of claim 1 wherein the step of transmitting the data transmission over a telephone system from the sender's location to an

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intermediate point of presence facility include converting the image data to facsimile format and transmitting the image data in the facsimile format (note column 5 lines 5-27).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes-Hartogs (U.S. patent 5,657,381) in view of Henrick (U.S. patent 6,151,137)

Regarding claim 9 Hughes-Hartogs does not clearly disclose: The method of claim 1 further including the steps of generating a confirmation message by the point of presence Facility after re-transmitting the data comprising the image Portion to the recipient's identified address and allowing the sender access to the confirmation message . On the other hand Henrick discloses: The method of claim 1 further including the steps of generating a confirmation message by the point of presence Facility after re-transmitting the data comprising the image Portion to the recipient's identified address and allowing the sender access to the confirmation message (note column 5 lines 32-44 where the confirmation message is send to the sender regarding the re-transmission of the facsimile data). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Hughes-Hartogs's invention according to the teaching of Henrick, Where Henrick in the same field of endeavor teach the way the confirmation report as the status of the received facsimile would be transmitted before the

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connection would be terminated, this would increase the capability of the whole facsimile system.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-Dehkordy whose telephone number is (571) 272-7462. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

Any response to this action should be mailed to:

Assistant Commissioner for Patents

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Washington, D.C. 20231

Or faxed to:

(571) 273-8300, (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

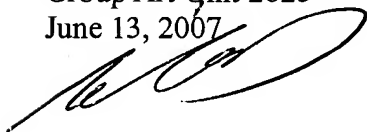
Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Knox building on 501 Dulany Street,
Alexandria, VA.

Any inquiry of a general nature or relating to the status of this application should be directed to
the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2625
June 13, 2007



KING Y. POON
PRIMARY EXAMINER